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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,227	04/16/2004	Tien-Jui Chi		7780

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/825,227

Applicant(s)

CHI, TIEN-JUI

Examiner

Catherine Simone

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation “the anti-slip rib is from 1 cm to 2 cm” in claim 36 is deemed vague and indefinite. Is it “1 cm to 2 cm” in width, height, thickness etc.? It is believed by the Examiner that it is regarding the width. Clarification is requested.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4-10, 13, 17-24 and 28-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumura et al. (US 5,055,340).

Regarding claims 1, 4, 13 and 23, Matsumura et al. discloses a grip tape for a golf club comprising a shockproof layer made from light-weighted material for buffering shock of stroke

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(see col. 2, lines 56-60), two long sides on the bottom thereof peeled into a specific thickness (Fig. 7, #4a); a fabric layer covered on top of the shockproof layer for adsorbing sweat (see col. 3, lines 2-9), and an anti-sliding layer (anti-slip rib) disposed on part of the fabric layer (Fig. 1, #3; also see col. 2, lines 35-41), together forming a ragged surface for the convenience of holding. Regarding claims 5, 19 and 30, the fabric layer is a fiber layer (see col. 1, lines 58-60). Regarding claims 7, 20 and 31, the anti-sliding layer (rib) is made from silicon (see col. 2, line 4). Regarding claims 8, 21 and 32, the anti-sliding layer (rib) is partially coated on the fabric layer by screen printing (see col. 2, lines 42-48). Regarding claims 9, 22 and 33, the anti-sliding layer (rib) has a plurality of embossed frame (see col. 2, lines 33-41). Regarding claims 10 and 28, the anti-sliding layer (rib) further has a special embossed pattern (see col. 2, lines 33-41). Regarding claim 17, the anti-slip rib further has an aligned nick for the alignment of the strip on an elastic sleeve of a golf club (see col. 2, lines 33-41). Regarding claim 24, the shockproof layer is a thermoplastic layer with damping function (see col. 2, lines 56-60).

Regarding claims 6, 8, 18, 21, 29 and 32, the limitations “the fabric layer is agglutinated on the surface of the shockproof layer by rolling” in claims 6, 18 and 29 and “by screen printing” in claims 8, 21 and 32 are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, 14, 15, 25, 26 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumura et al. (US 5,055,340) in view of Doubt (US 4,696,842).

Matsumura et al. discloses the claimed grip tape as detailed above except for the shock proof foam layer being composed by Styrene-Ethylene/Butylene-Styrene (SEBS) Copolymer and having a hardness ranging from the Shore C 35 degrees to 45 degrees. Doubt teaches that it is old and well-known in the art to form a hand grip made from Styrene-Ethylene/Butylene-Styrene (SEBS) Copolymer (see col. 2, line 65) having a hardness from the Shore C 35 degrees to 45 degrees for the purpose of providing a smooth gripping surface having a rubbery-type give or feel, but remains firm and dimensionally stable at any ambient temperature. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the shockproof foam layer of the grip tape in Matsumura et al. to be composed of a Styrene-Ethylene/Butylene-Styrene (SEBS) Copolymer having a hardness from the Shore C 35 degrees to 45 degrees as suggested by Doubt in order to provide a smooth gripping surface having a rubbery-type give or feel, but remains firm and dimensionally stable at any ambient temperature.

7. Claims 11, 12, 16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumura et al. (US 5,055,340) in view of Huang (US 5,584,482).

Matsumura et al. discloses the claimed grip tape as detailed above except for having a double-sided adhesive tape layer. Huang teaches that it is old and well-known in the art to use double-sided adhesive tape (see col. 2, lines 9-11) in order to wrap a grip strip spirally around the

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sleeve of a golf club and adhere it thereto to provide improved securement of the grip to the golf club shaft. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the grip tape in Matsumura et al. with a double-sided adhesive tape as suggested by Huang in order to wrap the grip tape spirally around the sleeve of a golf club and adhere it thereto to provide improved securement of the grip to the golf club shaft.

8. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumura et al. (US 5,055,340) in view of Reeves et al. (US 5,234,740).

Matsumura et al. discloses the claimed grip tape as detailed above except for the anti-slip rib having a width from 1 cm to 2 cm and the shockproof layer having a width from 2.2 cm to 2.4 cm. Reeves et al. teaches that is old and well-known in the art to have an anti-slip rib having a width from 1 cm to 2 cm and a shockproof layer having a width from 2.2 cm to 2.4 cm (see col. 3, lines 2-17) for the purpose of providing a grip with more uniform and more consistent slip control properties, thereby enhancing their safe use and convenient use. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the grip tape of Matsumura et al. with an anti-slip rib having a width from 1 cm to 2 cm and a shockproof layer having a width from 2.2 cm to 2.4 cm as suggested by Reeves et al. in order to provide the grip with more uniform and more consistent slip control properties, thereby enhancing their safe use and convenient use.

***Conclusion***


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine A. Simone  
Examiner  
Art Unit 1772  
September 16, 2005

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

9/19/05